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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,286	03/16/2001	Jacques Fieschi	FR920000012US1	5924

7590 04/06/2006

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EXAMINER

WORJLOH, JALATEE

ART UNIT PAPER NUMBER

3621

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/810,286

Applicant(s)

FIESCHI ET AL.

Examiner

Jalatee Worjloh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 22-27 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 9-20 and 27 is/are allowed.
6) ☒ Claim(s) 1-4, 8, 22-26 is/are rejected.
7) ☒ Claim(s) 5-7 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This Office Action is responsive to the amendment filed 03/20/2006.

Response to Arguments

2. Applicants' arguments, see pages 10 and, filed 03/20/2006, with respect to the rejection(s) of claim(s) 1, 9 and 16 under 35 USC 102 and 35 USC 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of US Patent No. 5999596 to Walker et al.

3. As per claim 1, Applicants argue that Slater fails to teach one of:

checking, by said electronic payment center, whether the electronic payment center has received a pre-validation from a third party;
contacting a third party via a communication network and requesting that the third party validate the purchase, and
containing a third party via a communication network and requesting said at least one PIN code from the third party,
wherein the third party is a prime owner of the credit/debit card.

The examiner agrees with Applicant that Slater fails to teach the step "wherein the third party is a prime owner of the credit/debit card". However, US Patent No. 5999596 to Walker et al. teaches the steps above and therefore cure this deficiency.

4. Applicants argue that claim 8 is not a single means claim. However, claim 8 teaches only one means for performing the steps of the method claim. A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d

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712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.).

When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

5. Applicants argue that “the plurality of PIN codes described and claimed in the present invention differ from the common PIN codes used on ATM machines to get cash which is disclosed in SLATER. Unlike the PIN codes commonly used and mentioned in SLATER, the PIN codes according to the present invention need not be secret, even if they are not disclosed to everyone.”

In response to this argument, the examiner notes that this feature upon which applicant relies (i.e., PIN codes are not secret) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Notice, the claim invention merely claims a PIN code, but does not explicitly distinguish this code from the conventional PIN codes. Applicants assert that the code is not a secret code, but instead a code that the seller knows. This alleged unique feature is not clearly expressed in the claims or specification. Thus, “One purpose for examining the specification is to determine if the patentee has limited the scope of the claims.’...For example, an inventor may choose to be his own lexicographer if he defines the specific terms used to describe the invention ‘with

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reasonable clarity, deliberateness, and precision.’ Such a definition may appear in the written description,...” *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002) (citations omitted). The meaning of Applicants’ PIN code is not defined “with reasonable clarity, deliberateness, and precision.”.

6. Applicant's arguments with respect to claim 26 have been considered but are moot in view of the new ground(s) of rejection.

7. Applicants argue that Hopkins does not expressly disclose verifying both an account number and a PIN, but instead the “it is clear from the cited passage that this is accomplished by checking a database.” Claim 4 recites, “said electronic payment center check in at least one profile table whether said PIN code is associated with the credit/debit card number.”, notice Hopkins checks in a database, which is known in the art of database management to have tables.

8. Arguments with respect to Fleming and Gifford have been considered and claims 5-7 have been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Applicants argue that Zampese and Lewis do not disclose or suggest an electronic payment center which interacts with a third party who is the prime owner of the card and perform the steps of Applicants invention. The examiner notes that the rejections did not use Zampese and Lewis were to show these details.

10. Claims 1-20, 22-27 have been examined.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 8 is rejected as being a single means claim.

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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13. Claims 1-3, 8 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6098053 to Slater in view of US Patent No. 5999596 to Walker et al.

Referring to claim 1, Slater discloses registering a purchase of at least one article by a buyer using a credit/debit card associated with at least one PIN code (security information including a secret number such as a personal identification number) at a seller terminal connected to an electronic payment center by a communication network (see col. 7, lines 26-40,60-63 – a purchaser places an order at a merchant's web site and enters his card number and PIN), checking, by the electronic payment center (i.e. "financial institution"), that the at least one PIN code which is provided by said buyer to said electronic payment center is associated with the number of said credit/debit card provided by said buyer to said seller terminal (see col. 9, lines 13-15,65-67; col. 10,line 1 – financial institution validates financial transaction instruction), checking, by said electronic payment center, with a third party (i.e. "purchaser's bank") whether or not said at least one PIN code is valid (see col. 10, lines 10-15,32-34). Also see Fig. 1. Slater does not expressly disclose one of: checking, by said electronic payment center, whether the electronic payment center has received a pre-validation from a third party, contacting a third party via a communication network and requesting that the third party validate the purchase, and contacting a third party via a communication network and requesting said at least one PIN code from the third party and wherein the third party is a prime owner of the credit/debit card. Walker et al. disclose one of: checking, by said electronic payment center, whether the electronic payment center has received a pre-validation from a third party (i.e. account holder), (see col. 9, lines 54-66 – if the account holder cannot be contacted then the default command stored in the field for the record is retrieved and executed. If the retrieved default command is authorize then

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processor will authorize the transaction in a conventional manner), contacting a third party via a communication network and requesting that the third party validate the purchase (see col. 10, lines 1-18 – if the account holder has been contacted, the processor will present a list of options to the account holder such as press 1 for authorizing this transaction, press 2 for declining the transaction), and contacting a third party via a communication network and requesting said at least one PIN code from the third party (see col. 10, lines 60-63) and wherein the third party is a prime owner of the credit/debit card (see col. 4, lines 26-33).

Referring to claim 2, Slater discloses the method wherein said buyer has a terminal (i.e. personal computer) which is connected to the communication network and said terminal is configured to transmit the number of the credit/debit card (see fig. 1, (12,13), col. 5, lines 44-55 and col. 7, lines 44-49).

Referring to claim 3, Slater discloses the method wherein the credit/debit card number and the at least one PIN code which have been provided to said seller terminal by said buyer are transmitted to said electronic payment center to check whether the at least one Pin code is associated with said credit/debit card number (see claim 1 above).

Referring to claim 8, see claim 1's rationale above.

Referring to claim 26, Slater discloses a payment center and a third party (see claim 1 above). Slater does not expressly disclose the third party is a living human being and wherein the method comprises not contacting the third party but instead checking, by said electronic payment center, whether the electronic payment center has received a pre-validation from the third party. Walker et al. disclose the third party is a living human being (i.e. account holder) and wherein the method comprises not contacting the third party but instead checking, by said

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electronic payment center, whether the electronic payment center has received a pre-validation from the third party (see col. 9, lines 54-66 – if the account holder cannot be contacted then the default command stored in the field for the record is retrieved and executed. Thus, if the retrieved default command is authorize then processor will authorize the transaction in a conventional manner). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Slater to include the step wherein the third party is a living human being and wherein the method comprises not contacting the third party but instead checking, by said electronic payment center, whether the electronic payment center has received a pre-validation from the third party. One of ordinary skill in the art would have been motivated to do this because prevents unauthorized individuals from using the card.

14. Claims 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slater and Walker et al. as applied to claim 3 above, and further in view of US Patent No. 5999624 to Hopkins.

Referring to claim 4, Slater discloses an electronic payment center (see claim 3 above). Slater does not expressly disclose the method wherein said electronic payment center checks in at least one profile table whether said PIN code is associated with the credit/debit card number. Hopkins discloses wherein said electronic payment center checks in at least one profile table whether said PIN code is associated with the credit/debit card number (see col. 9, lines 58-62). At the time the invention was made, it would have been obvious to a person of ordinary skill the art to modify the method disclose by Slater to include the step wherein said electronic payment

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center checks in at least one profile table whether said PIN code is associated with the credit/debit card number. One of ordinary skill in the art would have been motivated to do this because it verifies the user's identity, thereby minimizing fraud.

15. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Slater as applied to claim 1 above, and further in view of US Patent No. 6014650 to Zampese.

Slater discloses an electronic payment method (see claim 1 above). Slater does not expressly disclose the method wherein each PIN code of the at least one PIN code is used only once a different PIN code of the at least one PIN code is use for a later transaction. Zampese discloses the method wherein each PIN code of the at least one PIN code is used only once a different PIN code of the at least one PIN code is use for a later transaction (see col. 2, lines 1-4). At the time the invention was made, it would have been obvious to a person of ordinary skill the art to modify the method disclose by Slater to include the method wherein each PIN code of the at least one PIN code is used only once a different PIN code of the at least one PIN code is use for a later transaction. One of ordinary skill in the art would have been motivated to do this because it provides additional security thereby reducing fraud.

16. Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slater as applied to claim 1 above, and further in view of US Patent No. 6213391 to Lewis.

Referring to claims 23 and 24, Slater discloses an electronic payment method (see claim 1 above). Slater does not expressly disclose the method wherein the at least one PIN code is associated with two or more members of a group and the group is associated with the number of the credit/debit card. Lewis discloses the method wherein the at least one PIN code is associated

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with two or more members of a group and the group is associated with the number of the debit/credit card, wherein the at least one PIN code is different for different members of the group and wherein the at least one PIN code authorizes a different purchasing amount for the different members of the group (see col. 5, lines 40- col. 6, line 59). At the time the invention was made, it would have been obvious to a person of ordinary skill the art to modify the method disclose by Slater to include at least one PIN code is associated with two or more members of a group and the group is associated with the number of the debit/credit card. One of ordinary skill in the art would have been motivated to do this do this because it provides additional security.

Referring to claim 25, Slater discloses a third party who limits a buyer's payment to an amount of available credit, which is synonymous to the step wherein the third party is a member of the group and the third party limits a transaction involving the credit/debit card to a pre-determined purchasing amount (see col. 10, lines 40-50).

Allowable Subject Matter

17. Claims 5-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

18. Claims 9- 20 and 27 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is (571) 272-6714. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for Regular/After Final Actions and 571-273-6714 for Non-Official/Draft.

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Any response to this action should be mailed to:

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Jalatee Worjloh
Patent Examiner
Art Unit 3621

April 3, 2006

**JAMES A. REAGAN
PRIMARY EXAMINER**

